



Atty. Dkt. No. 038602-1180

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Gregory D. PLOWMAN et al.

Title: MAMMALIAN PROTEIN
PHOSPHATASES

Appl. No.: 09/866,987

Filing Date: 05/30/2001

Examiner: Nashaat T. Nashed

Art Unit: 1652

RECEIVED
JAN 28 2003
TECH CENTER 1600/2900

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
Washington, D.C. 20231

Sir:

In response to the restriction requirement set forth in the Office Action mailed September 24, 2002, the due date for response having been extended three months to January 24, 2003, Applicants hereby provisionally elect Group 8, Claims 6-8, drawn to the protein phosphatase of SEQ ID NO: 8, for examination, with traverse.

Applicants concurrently file herewith a Petition for Extension of Time under 37 C.F.R. § 1.136(a), with provision for the required fee, to extend the period for response for three months, up to and including January 24, 2003. If additional fees are necessary to prevent abandonment of this application, the Commissioner is hereby authorized to charge Deposit Account No. 19-0741.

The Examiner has required the following restriction:

A. Groups 1-5: Claims 1-5 and 26-32, drawn to nucleic acid encoding the protein phosphatase of SEQ ID NO:X, vector and host cell: X = 6-10, respectively;

B. Groups 6-10: Claims 6-8, drawn to the protein phosphatase of SEQ ID NO:X, X = 6-10, respectively;

C. Groups 11-15: Claims 9-11, drawn to antibody raised against the protein phosphatase of SEQ ID NO:X and a method of use, X = 6-10, respectively;

D. Groups 16-20: Claims 12-13, drawn to a method of identifying a compound that binds to the protein phosphatase of SEQ ID NO:X, X = 6-10, respectively;

E. Groups 21-25: Claims 14-20, drawn to a method of treating diseases by administering to a patient a modulator of the protein phosphatase of SEQ ID NO:X, X = 6-10, respectively; and

F. Groups 26-30: Claims 21-25, drawn to a hybridization method of detecting the protein phosphatase of SEQ ID NO:X (presumed to be to detect the nucleic acid encoding the polypeptide), X = 6-10, respectively.

In regard to the election of Group 8, with traverse, Applicants respectfully disagree with the Examiner's rationale for requiring restriction between the amino acid of SEQ ID NO: 8 and the nucleic acid encoding the protein phosphatase of SEQ ID NO: 8 (Group 3). It is believed that the subject matter of the claims of Groups 3 and 8 are sufficiently related to be examined together, and such examination would not place an undue burden on the Examiner. When the amino acid of SEQ ID NO: 8 is searched, the nucleic acid encoding the amino acid of SEQ ID NO: 8 is also searched. MPEP 803 recites that if "the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions." Additionally, if the Examiner agrees to combine Groups 3 and 8, Group 23 (claims 21-25, drawn to a hybridization method of detection the protein phosphatase of SEQ ID NO: 8) should also be combined, as the method utilizes a nucleic acid probe which hybridizes under highly stringent conditions to a nucleic acid target region of a phosphatase polypeptide having an amino acid sequence of SEQ ID NO: 8.

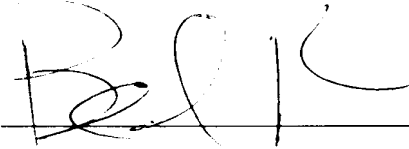
Applicants, of course, reserve the right to file a divisional application covering the subject matter of the non-elected claims. Examination on the merits is kindly requested.

Respectfully submitted,

Date

1/23/03

By



FOLEY & LARDNER

Customer Number: 22428



22428

PATENT TRADE-MARK OFFICE

Telephone: (202) 672-5475

Facsimile: (202) 672-5399

Beth A. Burrous

Attorney for Applicant

Registration No. 35,087

Should additional fees be necessary in connection with the filing of this paper, or if a petition for extension of time is required for timely acceptance of same, the Commissioner is hereby authorized to charge Deposit Account No. 19-0741 for any such fees; and applicant(s) hereby petition for any needed extension of time.